

REMARKS

Claims 1-15 and 20-27 are pending in the application.

Claims 1-15 and 20-27 have been rejected.

No Claim has been amended, and reconsideration of the Claims is respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-3, 11, 13, 21 and 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hiscock (US 6,721,787). The rejection is respectfully traversed.

As set forth more fully below, the previously filed Declaration of Prior Invention is sufficient and effective to overcome the Hiscock reference as prior art.

II. **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Haartsen (US 6,590,928). Claims 6-7 and 14-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Treyz (US 6,678,215). Claims 8, 22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Jones (US 6,108,314). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Callaway, Jr. (US 6,711,380). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of McClard (“Unleashed: Web Tablet Integration Into the Home”). Claim

12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Nevo (US 6,600,726). Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Thompson (US 6,484,011). Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiscock (US 6,721,787) in view of Gershman (US 6,356,905). The rejections are respectfully traversed.

All of the above § 103(a) rejections are based upon Hiscock as the primary reference. As set forth more fully below, the previously filed Declaration of Prior Invention is sufficient and effective to overcome the Hiscock reference as prior art.

III. DECLARATION OF PRIOR INVENTION UNDER 37 CFR § 1.131

The Office Action argues that the Declaration of Prior Invention Under C.F.R. § 1.131 is ineffective to overcome the Hiscock reference for the following reasons: (A) the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hiscock reference, and (B) the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hiscock reference to either a constructive reduction to practice or an actual reduction to practice.¹ These findings are respectfully traversed, as more fully explained below:

¹ The Office Action also addresses reduction to practice and implies a requirement that the invention must have been actually reduced to practice. It is fundamental that the filing date of the application may be relied upon for constructive reduction to practice, though Applicant reserves the right to submit evidence of actual reduction to practice prior to the effective date.

A. CONCEPTION

It is uncontroverted by the Office, and the Declaration is fully sufficient to show, that the document entitled “BlueTooth Strategy Review” and its informational content (hereinafter referred to as the “BlueTooth document”) existed and was conveyed and distributed within the assignee’s predecessor (Nextcell) prior to the effective date of the Hiscock reference. Thus, the Office’s basis for insufficiency is that the BlueTooth document’s contents fail to provide sufficient evidence of “conception” of the invention.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. “[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill.” *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without “exercise of the inventive faculty.” *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978); see also, *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”). See, MPEP §§ 2138.04 and 715.07.

For ease of reference, Applicant sets forth representative independent Claim 1 in its entirety below:

1. A personal wireless network, comprising:
 - a wireless server capable of executing any one of a plurality of software applications and generating from such execution a plurality of data packets for transmission in the network;
 - a wireless client capable of wireless communication with the wireless server in accordance with at least one wireless communication protocol, the wireless client being configured to remotely access the software applications executed by the wireless server, and to process the data packets transmitted from the wireless server; and
 - wherein the wireless server receives a data packet from the wireless client, extracts data from the received data packet, and associates the extracted data with one of the software applications.

Applicant respectfully submits that each of the above elements/features is disclosed or described in Applicant's BlueTooth document. To clearly illustrate this, Applicant attaches Exhibit A (two pages) that includes a chart identifying the elements/features of independent Claim 1 and their corresponding support as disclosed in the BlueTooth document. See Exhibit A². For ease of reference, Applicant is providing another copy of the BlueTooth (with page numbers added).

The interaction and association of these components is described sufficiently within the BlueTooth document to illustrate the conception of the invention. Applicant respectfully submits

² Applicant has not prepared and included separate charts for each of the independent Claims 21, 23, 25 since these Claims recite elements similar to the elements in independent Claim 1. Applicant respectfully submits that the Examiner can use Exhibit A to easily correlate the similar elements in the independent Claims 21, 23, 25 to the disclosure/teachings in the BlueTooth document.

that the Bluetooth document sufficiently illustrates conception of the invention prior to the critical date. See, Exhibit A.

B. DILIGENCE

The critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). See, MPEP § 715.07(a). The diligence of 35 U.S.C. 102(g) relates to reasonable "attorney-diligence" and "engineering-diligence" (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that "an inventor or his attorney drop all other work and concentrate on the particular invention involved" *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974).

Thus, Applicant must show reasonable diligence from February 9, 2000 (one day prior to the effective date of the Hiscock reference) up until an actual or constructive reduction to practice. Constructive reduction to practice occurred on the June 16, 2000 filing of United States application Ser. No. 60/212,203, the provisional application upon which the present application claims priority.³ Therefore, Applicant must show reasonable diligence to the reduction to practice between February 9, 2000 and June 16, 2000 -- roughly four (4) months.

Applicant respectfully request that the Examiner review United States provisional Application Ser. No. 60,212,203. This US provisional application comprises (1) the BlueTooth

³ Applicant reserves its rights to show an actual reduction of practice prior to the filing date of the US provisional application.

document, the (2) BlueTooth Network Solution Product Features document (version 1.0), and (3) additional figures. The Blue Tooth Network Solution Product Features document was generated on or before May 9, 2000 (within three months after the onset of the diligence period). Within six weeks thereafter, Applicant filed the U.S. application 60/212,203 that included the BlueTooth document, the BlueTooth Network Solution Product Features document, and additional figures, such as Figure 1, that fully describe Applicant's invention. This sequence of events fully and indisputably supports the conclusion that Applicant engaged in reasonable due diligence during the critical period. Specifically, that sequence demonstrates that Applicant was engaged in production of further documentation and/or development of its products in order to reduce the invention to practice (and more fully describe the invention). Moreover, six weeks is a reasonable period of time after completion of this further documentation to seek, retain and forward the documentation to a patent attorney and obtain filing of the patent application. Thus, the efforts and sequence of events Applicant engaged in during the 4 month time period conclusively show that Applicant was properly and reasonably engaging in activities to reduce the conceived invention to practice.

Based on this, Applicant respectfully submits that Applicant engaged in reasonable diligence during the relevant period between February 9, 2000 and June 16, 2000 in order to reduce the invention to practice (at least constructively).

C. CONCLUSION

Applicant respectfully submits that the previously filed Declaration of Prior Invention provides sufficient evidence of prior invention to overcome the Hiscock reference.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: 1/26/2007



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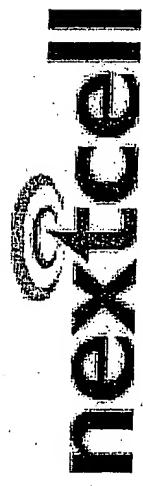
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EXHIBIT A

Independent Claim 1	Disclosure in "Bluetooth Strategy Review"
A personal wireless network comprising:	Page 4: Personal area network. Beginning at Page 9: "The Nextcell Bluetooth Network" may comprise (1) a "Home Network" as shown on page 11 (figure describing wireless communication between a PC and a wireless client), or (2) an "Enterprise Network" as shown on page 19. Page 16: Home Network Features – describes that the home network is "Used as a wireless extension of the PC within the home."
a wireless server	Page 11: Home network (figure describing wireless communication between a PC and a wireless client). Page 12: The "Home Network Components" include a "PC [personal computer] with BT [Bluetooth] module." The PC is a wireless server.
capable of executing any one of a plurality of software applications	Page 12 describes "Software Applications [SW] running on the PC" including "SW to launch applications, SW to route video to a BT device, [and] SW to perform network routing." Page 15: BT Tablet can access PC SW Applications. Page 16: Home Network Features – "User has access to all applications on the PC." Applications on the PC are software applications.
and generating from such execution a plurality of data packets for transmission in the network;	Page 11: "With a BT network, video is transmitted to the tablets from the PC platform." The term data packets includes video packets.
a wireless client	Page 11: Home network (the figure describes wireless communication between a PC and a wireless client). Page 12: The "Home Network Components" further include a "BT Tablet." Page 15: BT Tablet can access PC SW Applications.

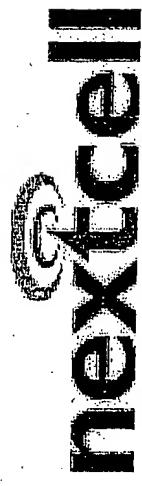
capable of wireless communication with the wireless server in accordance with at least one wireless communication protocol,	Page 13 describes that the BT Tablet is enabled for communication with “Real-Time Video Support” or “802.11 Support.” Page 15: Home Network Features – describes that “output is transmitted via BT link [BlueTooth wireless communication protocol] to a tablet [wireless client]”
the wireless client being configured to remotely access the software applications executed by the wireless server,	Page 15 describes that the “BT Tablet can access...PC SW Applications.” As described on page 16, the BT Tablet “User has access to all applications on the PC.”
and to process the data packets transmitted from the wireless server; and	As described on page 16, “Video output is transmitted via BT link to tablet(s).” As further described on page 16, the “Video refresh rate over a 732.2 Kbps asynchronous channel is approximately 3.4 seconds.” The tablet therefore processes video packets.
wherein the wireless server receives a data packet from the wireless client, extracts data from the received data packet, and associates the extracted data with one of the software applications.	Page 13 describes that “The user has the option to access the BT enabled server for specific applications.” If, for example, the application is “Handwriting Recognition” as shown on page 26, then “Once the data is transferred, an application is executed against the digital ink information.” Thus, the server associates received data with a particular application such as Handwriting Recognition.

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Bluetooth Strategy Review

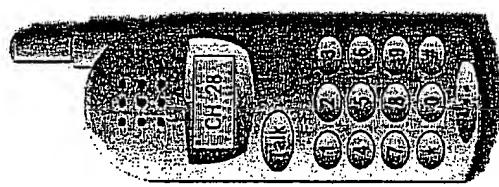
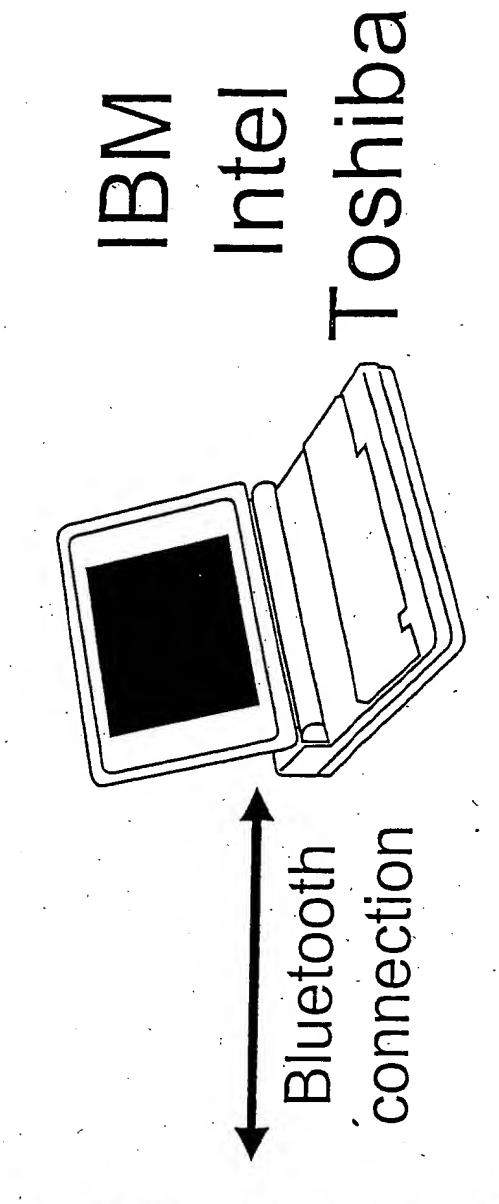
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The Bluetooth Beginning

Wireless Phone - Computer merge

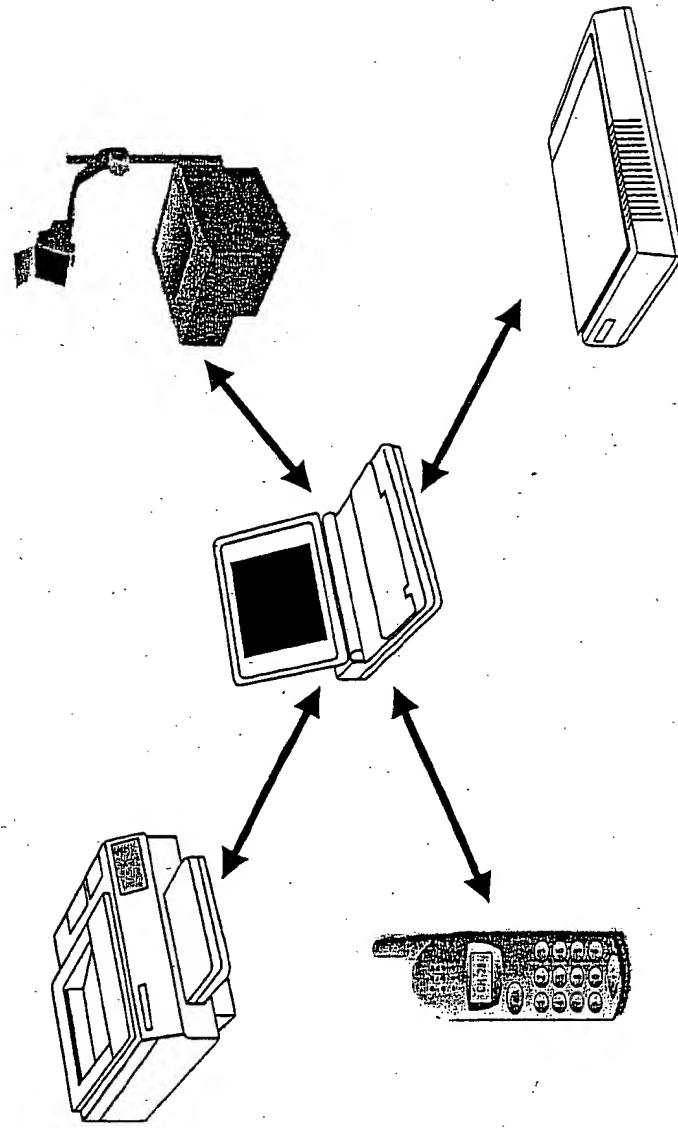


Ericsson
Nokia

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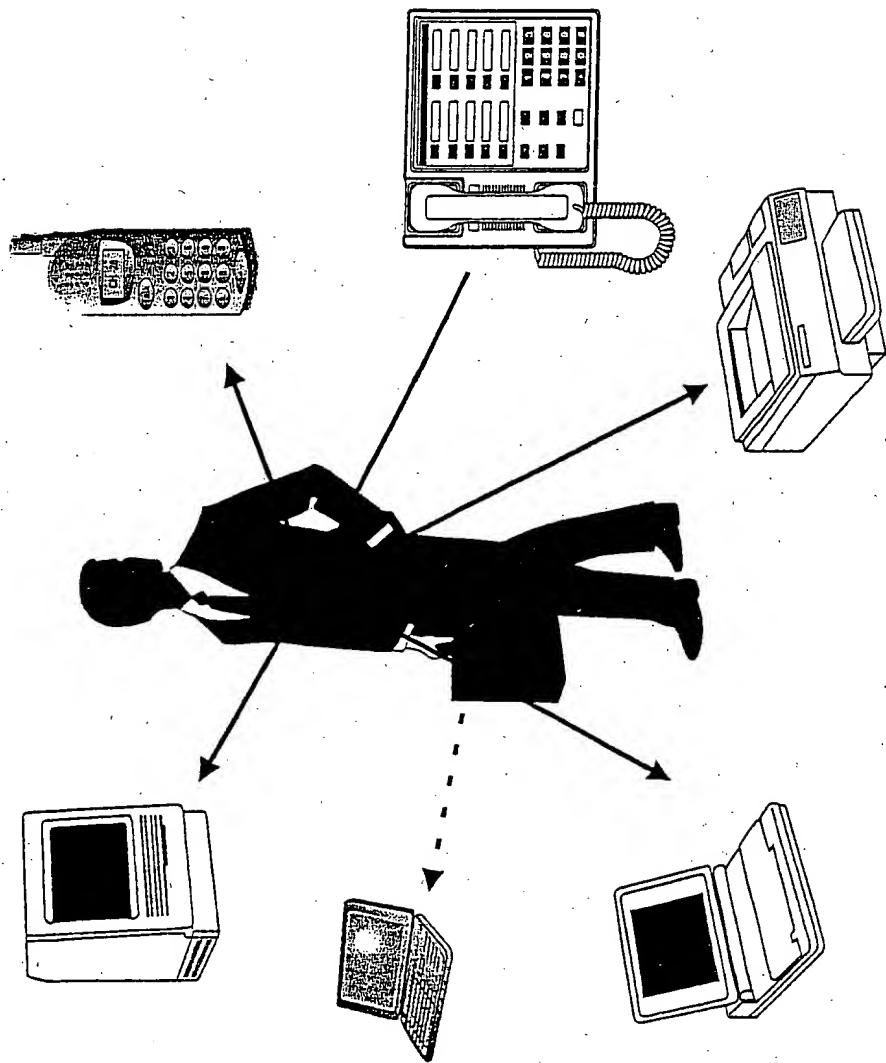
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Bluetooth Evolution -Cable Replacement-



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Bluetooth Evolution Personal Area Network



Bluetooth's Target Usage

- Personal Area Network (PAN)
- Point to point data transfer
- Components are low cost commodities
- No RF expertise required to implement

Typical Bluetooth Implementation

- Companies will be adding Bluetooth to existing products to make product differentiation, re-sell to existing customers, or to add new functionality.
- There is little talk about 'Bluetooth products', only current products that have been Bluetooth enabled.

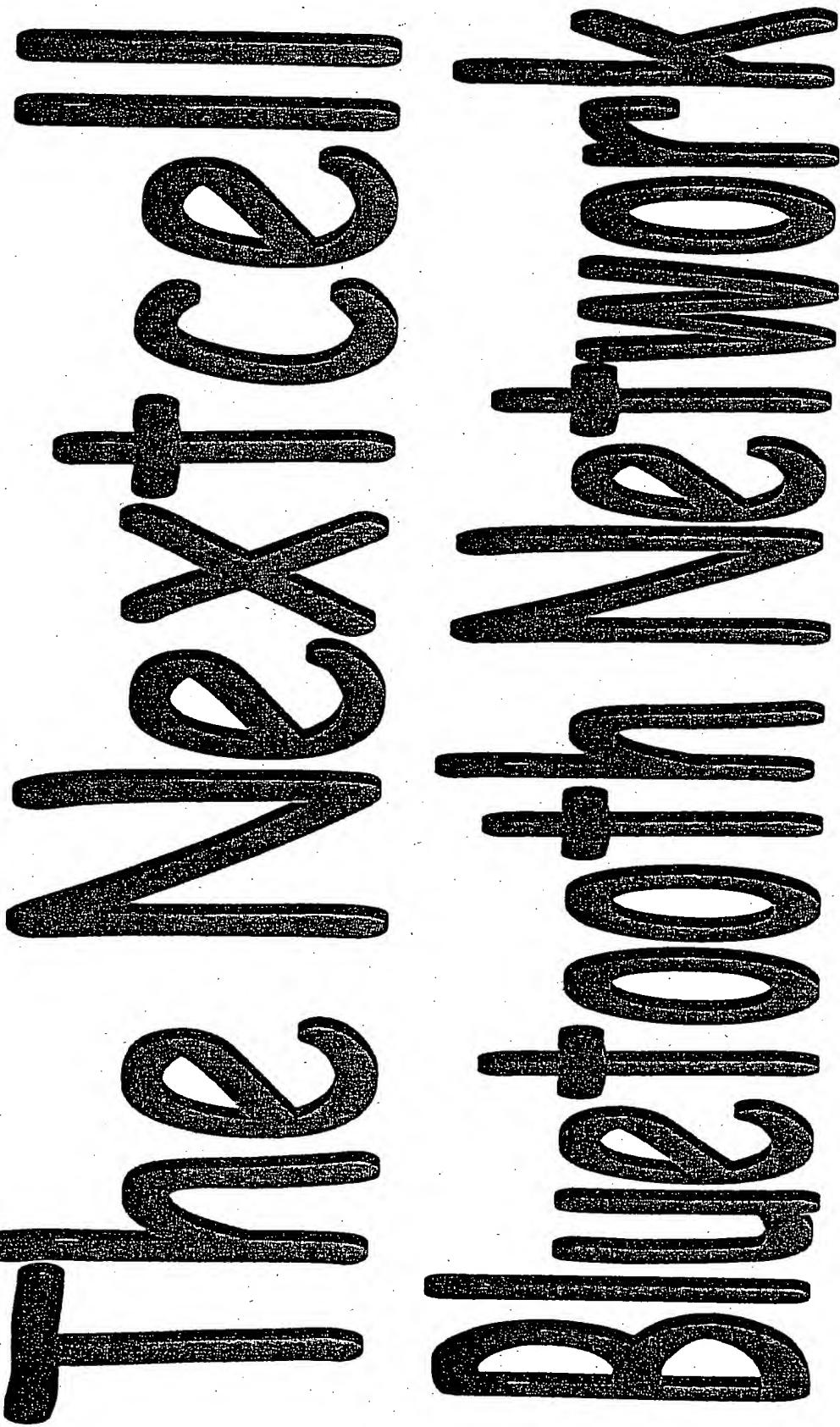
Typical implementation applied to Nextcell

- Adding Bluetooth to our CDPD or GPRS products will only marginally increase number of sockets.
- Total sales will still depend more on other outside factors such as traffic speed and cost, infrastructure, and applications.



Nextcell's Opportunities

- Take a system view of Bluetooth
- Develop a implementation radically different then the rest of the Bluetooth community.
- Develop in a product area which will be new to Nextcell and unique in the market.



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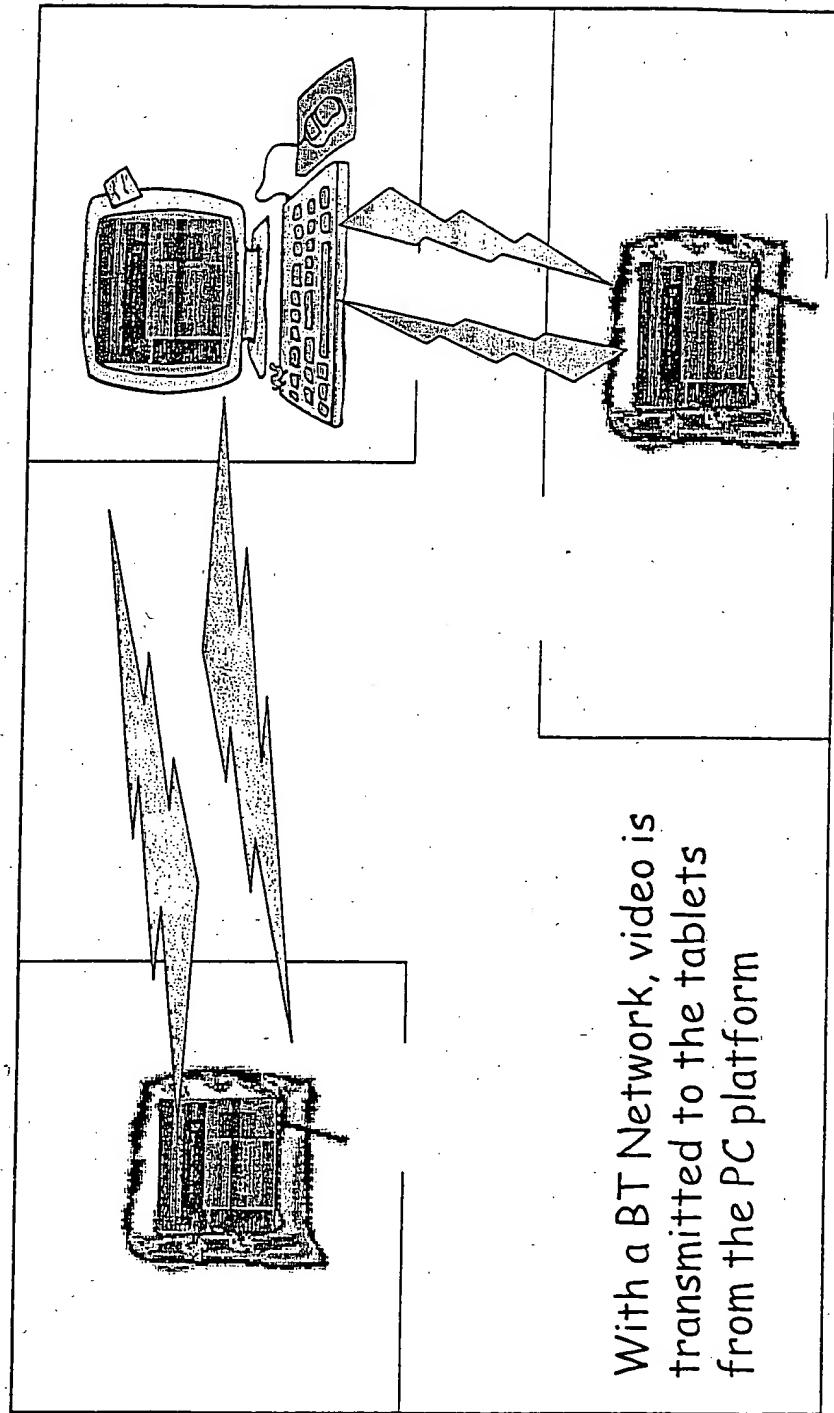
Why a Bluetooth Network?

- Simpler Scalability
 - Cheaper (802.11 and Bluetooth)
- Portability
 - Adhoc Nature
- BT Scatternet Experts
 - Current BT market focusing on Point-to-Point
- Multi-market appeal
 - Consumer/home
 - SOHO
 - Enterprise
 - Industry specific

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Home Network

FUTURE NETWORK



With a BT Network, video is transmitted to the tablets from the PC platform

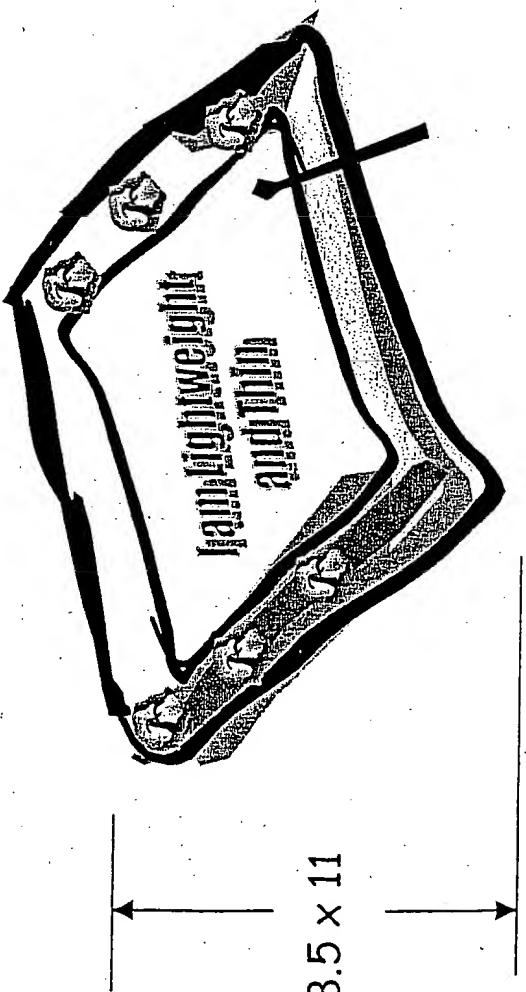
Home Network Components

- Hardware
 - HW interface to PC with BT module
 - BT Tablet
- Software Applications running on the PC
 - SW to launch applications
 - SW to route video to a BT Device
 - SW to perform network routing
 - SW keyboard for data input

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Tablet Evolution

- Better Graphics
- Increase Size of the Display
- Lower Cost
- Real-Time Video Support
- Keyboard
- Different Stylus Types
- 802.11 Support
- Credit Card Readers (point-of-sale)

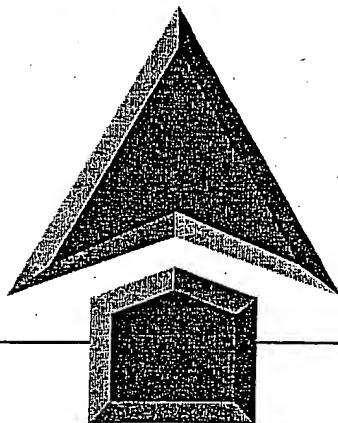




Preliminary Table Component Cost

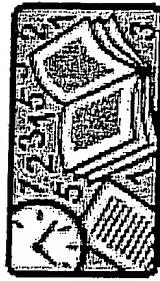
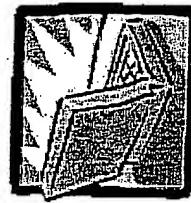
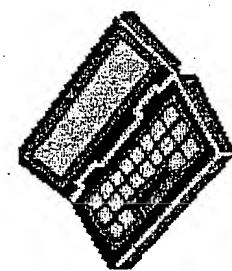
LCD	\$80	
Processor	\$20	
Battery	\$20	
Charger	\$10	
Audio	\$5	
BT module	\$15	
Packaging	\$20	
Assembly	\$20	

\$190



Product Differentiators

- Palm Pilot
- Laptop
- eBook Reader



BT Tablet has
Better Graphics

BT Tablet can access
other BT devices and
PC SW Applications

BT Tablet costs
less

BT Tablet has Internet
Access

BT Tablet can access
other BT devices and
PC SW Applications





Home Network Features

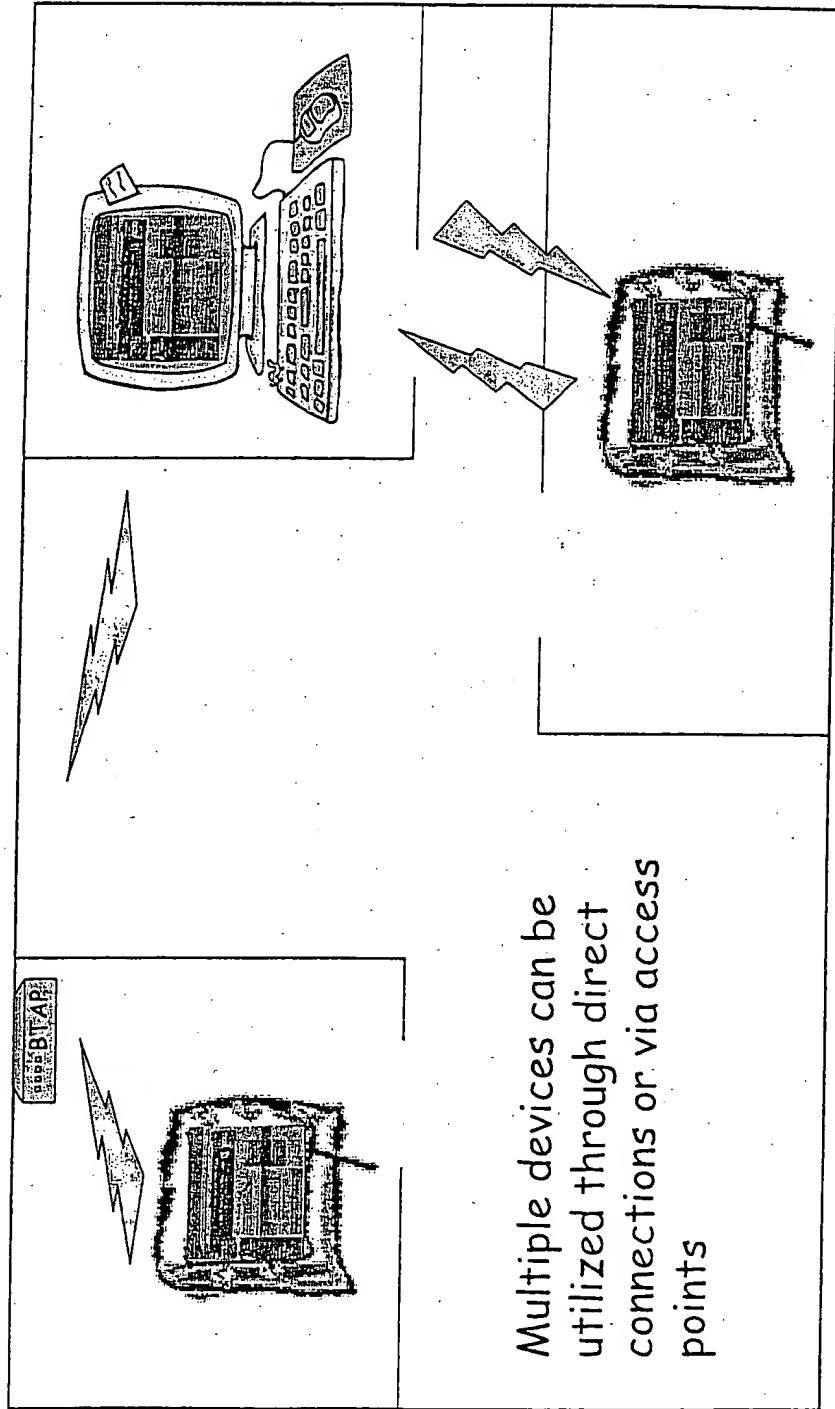
- Used as a wireless extension of the PC within the home
- Video output is transmitted via BT link to tablet(s)
- User has access to all applications on the PC
- Tablet could also act as a device dependent portal for advertising, as well as Internet surfing and eBooks access
- Video refresh rate over a 732.2 Kbps asynchronous channel is approximately 3.4 seconds
- Tablet has potential to access other BT devices
 - 3rd party devices
 - Additional BT Nextcell devices
 - BT to IR/IR to BT converter (consolidate remote controls)
 - BT repeater
- Architect the solution for expansion via software upgrade
 - Nextcell controlled code

Office Automation

- Two target markets
 - SOHO
 - Enterprise
- SOHO
 - Consumer product solution could be used for supporting a small number of devices in a small office setting
- Enterprise
 - Additional network capability can be added to enhance the overall solution

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SOHO Network





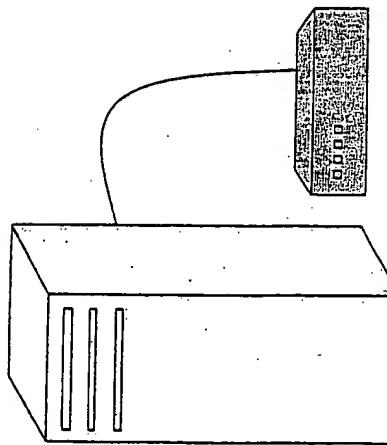
Enterprise Network

- Additional network capabilities
- BT Server
 - Server product that facilitates BT-specific applications
 - Integrated 802.11 transceiver operating at 5.2 GHz
- BT Access Point
 - Utilize alternative wireless access in conjunction with BT for transport
 - 802.11 at 5.2 GHz
- PBX interface
 - Port PBX information/functionality to tablet
 - CID to tablet when away from desk
 - Unified messaging
 - Phone setup and management
 - Potential for remote voice support

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Bluetooth Server

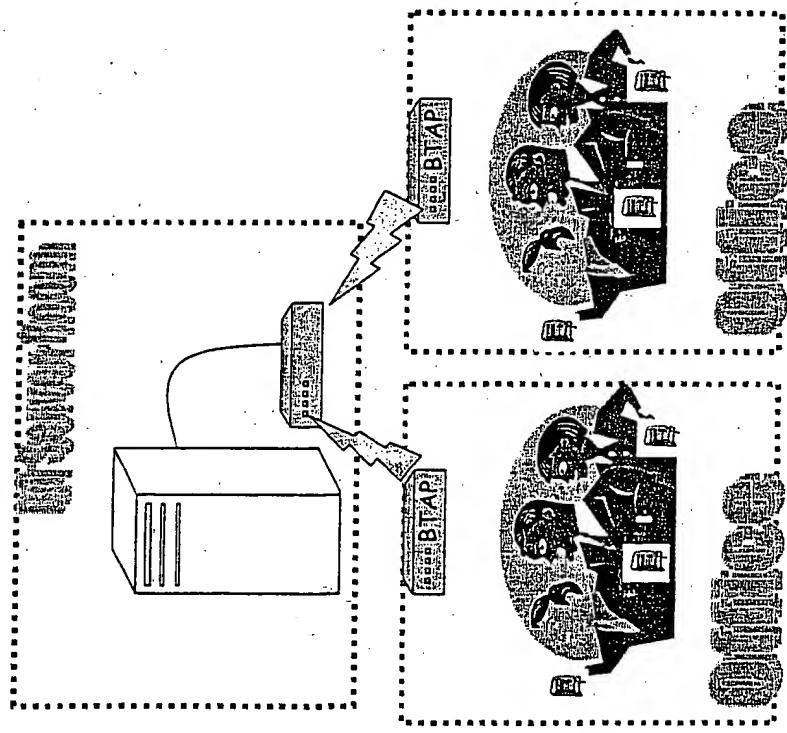
- RS232 Connection to Server or PC Card
- 802.11 Capability - Used with BTAP
- Manages multiple network interconnections
- Would implement BT specific applications
- Would follow LAN access profile defined by BT SIG



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Bluetooth AP

- 802.11 Capability - Used as a high-speed, wireless backbone for data communication
- Used for Picking up to 7 Bluetooth Devices that are within 100 meters from BTAP
- Spaced every 100 meters or less.
- May be used in every office for Bluetooth devices.

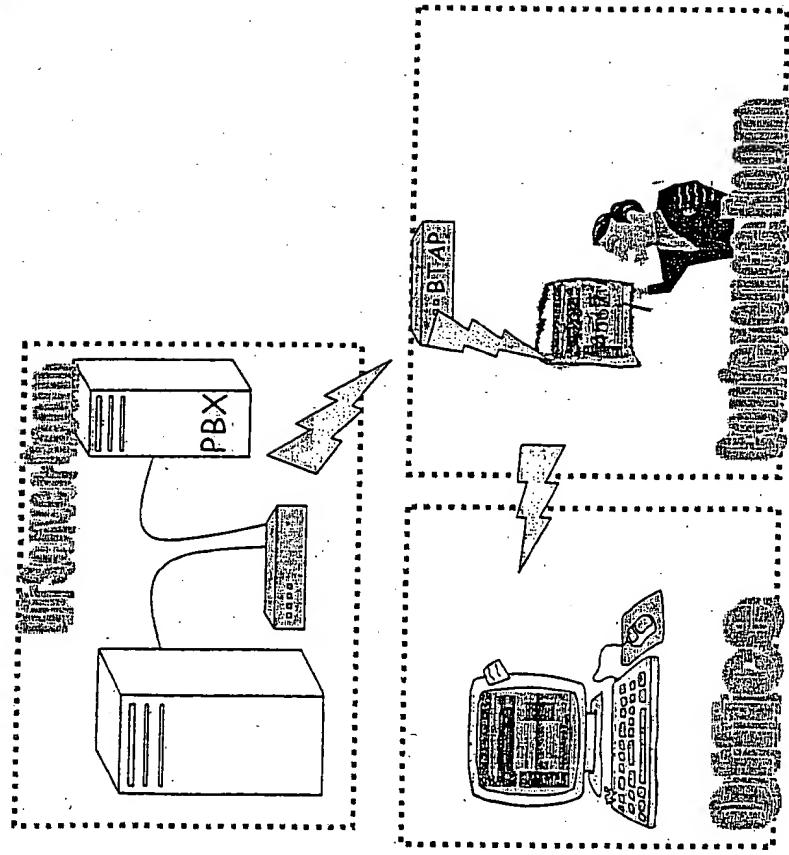


Enterprise Network Concepts

- Server and/or workstation access
- Inter-office paging/messaging
- Whiteboard/application sharing
- Handwriting recognition

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Server and/or Workstation Access

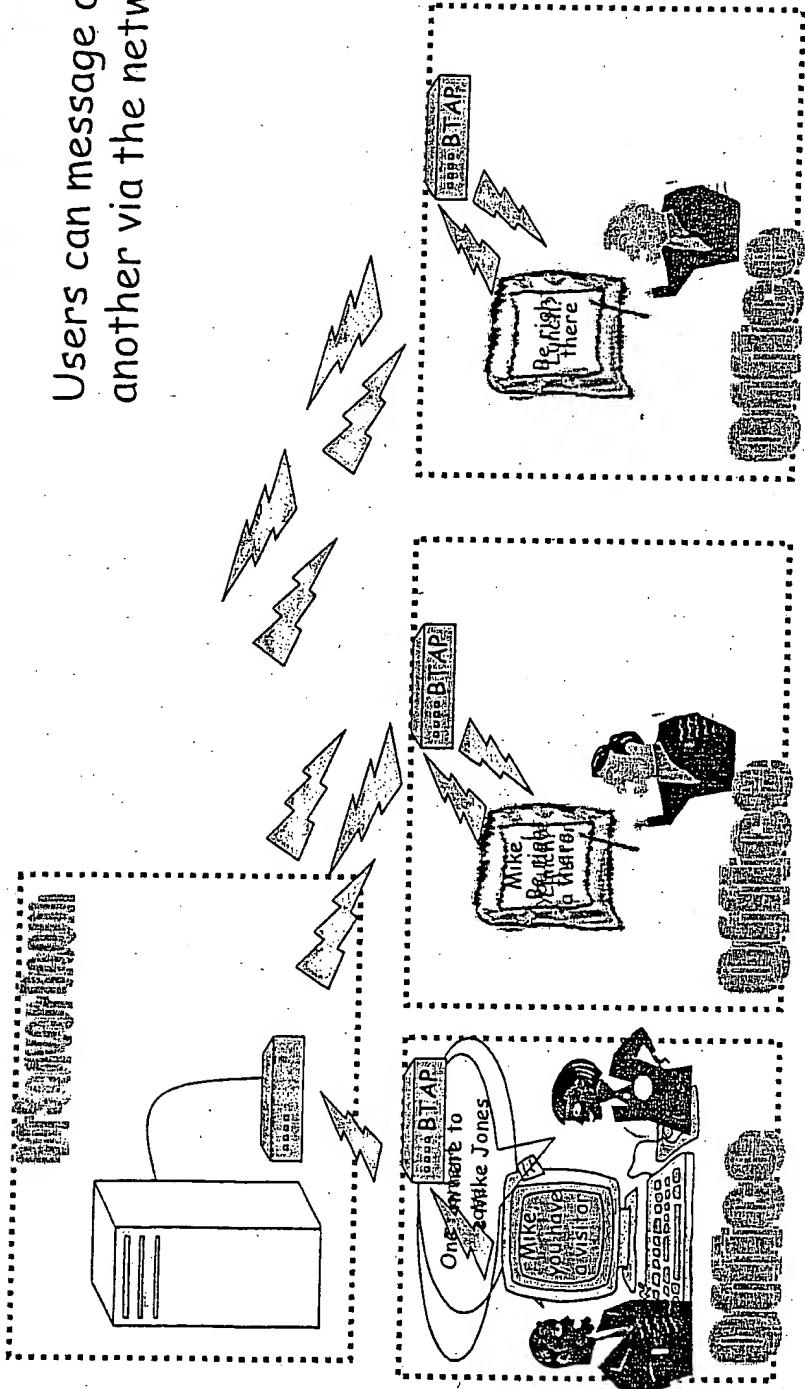


The user also has the option to access the BT enabled server for specific applications

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Inter-office paging/messaging

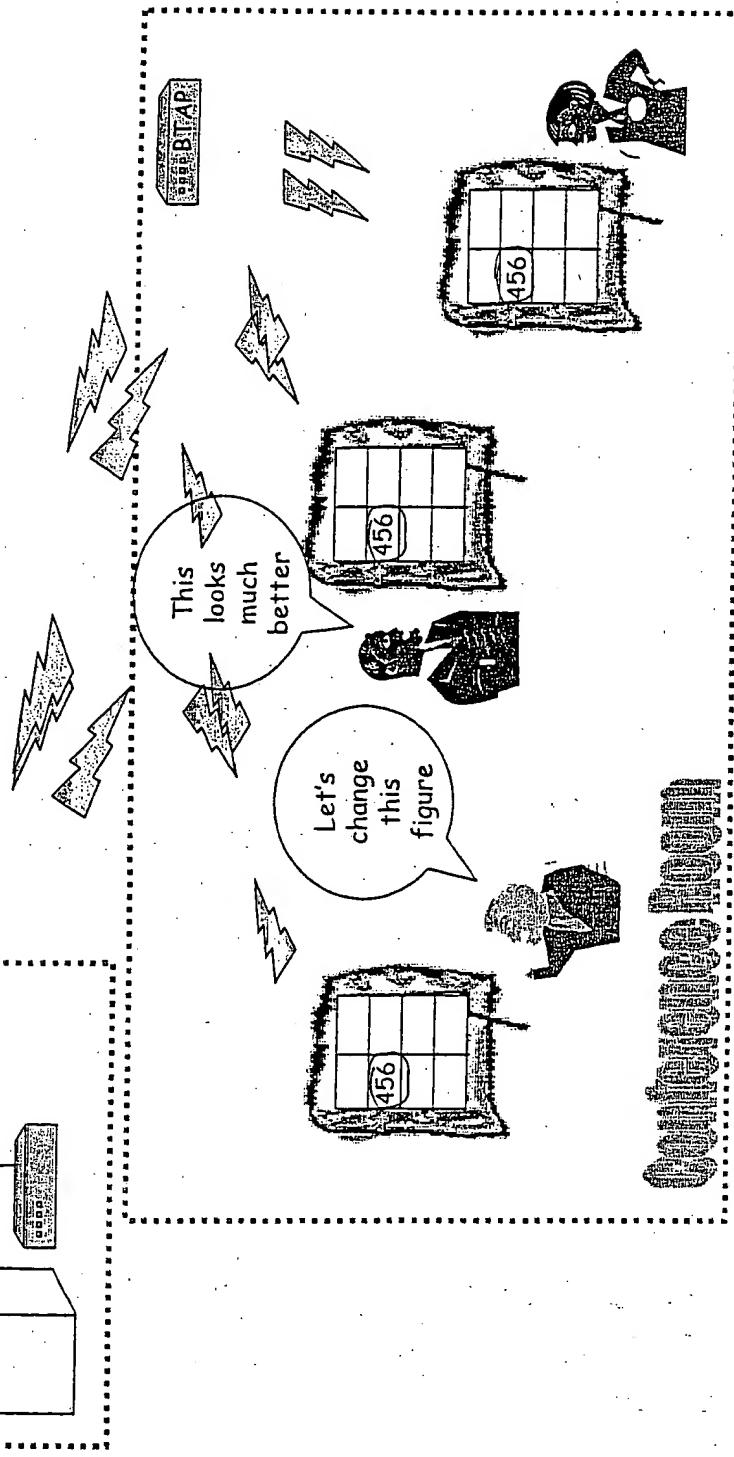
Users can message one another via the network



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Whiteboard/Application Sharing

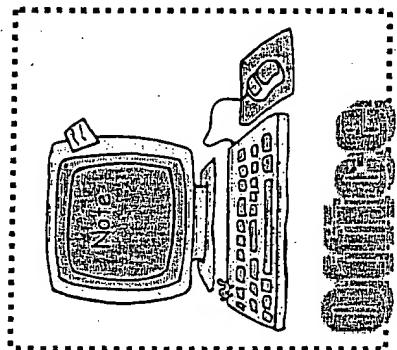
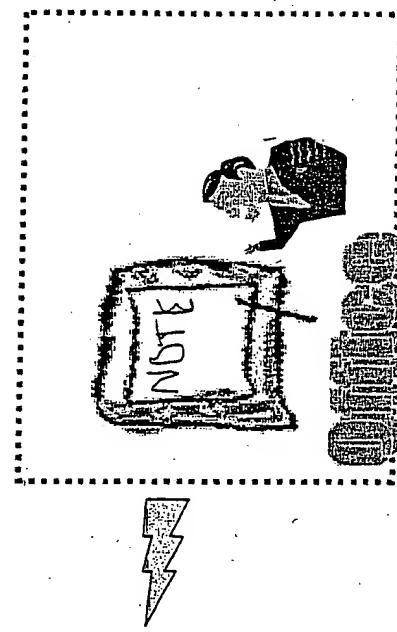
Documents can be marked-up with digital ink to allow dynamic interaction



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Handwriting Recognition

Once the data is transferred, an application is executed against the digital ink information



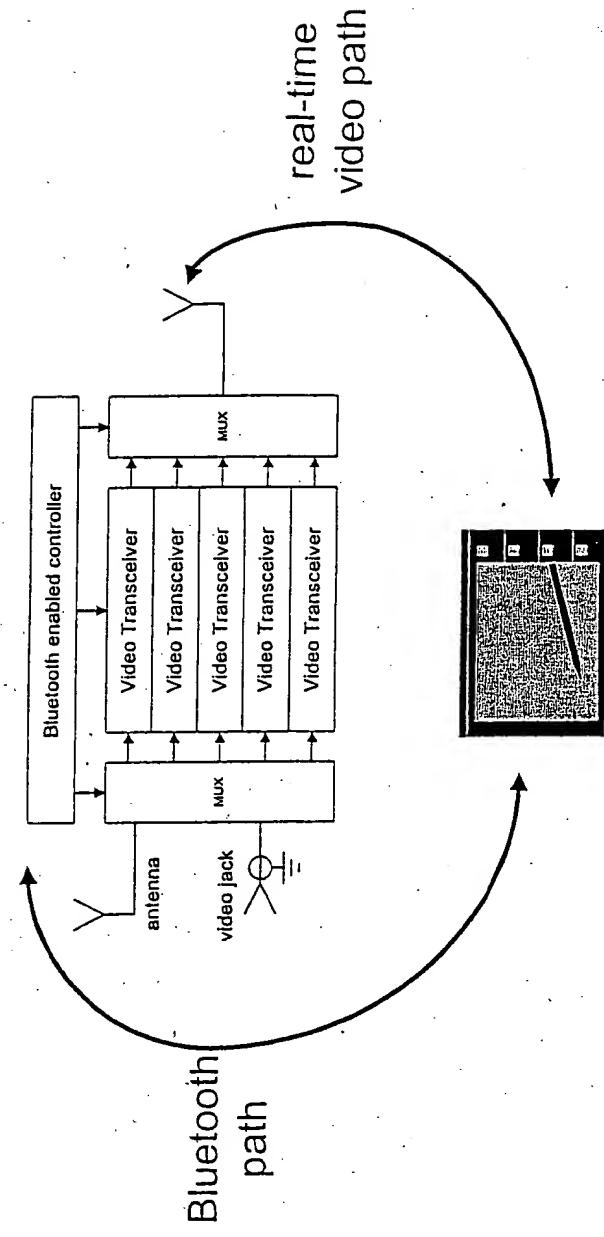
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Auxiliary System Components

- Real time Video
- Wireless keyboard
- BT Phone
- HomeRF adapters

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Adding real time video to the Bluetooth Network





Other Network Environments

- Restaurants Take and fill orders, billing
- Schools Test taking, reading
- Sales Less equipment
- Hospitals Access Records
- Airplanes Internet Access
- Hotels use with AOL
- Custom Application Design
 - Opportunity to design and develop industry specific solutions incorporating the product(s)

Content Relationship Approach

- Could we subsidize the HW cost with content relationship for a particular service?
- Partner with solution specific web entity
 - Design application(s) that are only accessible through the BT Network design
 - Device dependent portal
 - Service examples
 - Autobytel
 - Vehicle specific transaction service
 - PeaPod
 - Shopping application
- Aether
 - Real-time trading and market information
 - Portfolio management
 - Day trading
- DirecTV
 - Utilize web-centric programming guides for creation of custom remote control and viewing options

Next Steps Towards Defining the Project

- Tablet Graphics
 - Analyze LCD display options
 - Learn 'touch screen' technology
 - Get familiar with graphics files, compression and transmission options
- Server Architecture
 - Research remote application startup in virtual video mode
 - Research sending video over serial port
 - Further define routing requirements
- Bluetooth Component
 - Start a Bluetooth emulation over a COM1 serial port
 - Start designing L2CAP layer

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